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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/247,886	02/10/99	PUNNONEN	J 18097-030200

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EXAMINER

CHEN, S

ART UNIT	PAPER NUMBER
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1633

DATE MAILED:

04/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/247,886

Applicant(s)

Punnonen et al.

Examiner

Shin-Lin Chen

Group Art Unit

1633



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire thirty days from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-50 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-50 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to a method for obtaining a cell-specific binding molecule useful for increasing uptake or specificity of a genetic vaccine to a target cell by creating a library of recombinant polynucleotides comprising a nucleic acid binding domain encoding a transcriptional regulator, a histone, or a leucine zipper protein etc., and a cell-specific ligand encoding CD2 ligand, CD40 ligand, fibrinogen etc., classifiable in class 435, subclass 6 .
 - II. Claims 24-50, drawn to a method of obtaining a genetic vaccine component that confers upon a vector, such as replicable genetic package, an enhanced ability to enter an antigen-presenting cell by creating a library of recombinant nucleic acids containing at least two forms of a polynucleotide and contacting a library of vectors, comprising a fusion protein displayed on the surface of the replicable package, with a population of antigen-presenting cells (APC) or antigen processing cells to determine the percentage of cells that contain the vector, and to recover replicable genetic packages specifically bind to APCs, classifiable in class 435, subclass 5.
2. The inventions are distinct, each from the other because of the following reasons:

Groups I-II are patentably distinct from each other because they are drawn to different scientific considerations. The scientific considerations for group I are: creating a library of recombinant polynucleotides comprising a nucleic acid binding domain encoding a

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transcriptional regulator, a histone, or a leucine zipper protein etc., and a cell-specific ligand, and to identify a recombinant polynucleotide encodes a binding molecule that bind to a nucleic acid and to a cell-specific receptor. The scientific considerations for group II are: construction of a library of replicable genetic packages, such as a phage, comprising recombinant polynucleotides operatively linked to a polynucleotide that encodes a display polypeptide which are expressed as a fusion protein, and contacting the library of vectors with a population of antigen-presenting cells (APC) or antigen processing cells to determine the percentage of cells that contain the vector and to recover replicable genetic packages specifically bind to APCs. Group I is drawn to a method to identify a recombinant polynucleotide encoding a binding molecule that binds to a nucleic acid and a cell specific receptor; however, group II is drawn to a method to identify the APCs containing a vector comprising a at least two forms of a polynucleotide or a replicable genetic package such as phage specifically binds to APCs. Thus, groups I and II are drawn to different methods for different purposes. Further the classification for each group is different, thus, the search for each group would not be coextensive.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuayder can be reached on (703) 308-0447. The fax phone number for this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Shin-Lin Chen, Ph.D.



JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600